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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,190	02/04/2002	Kozo Shiokawa	Bayer 6708.2-Rci	7916

7590

05/14/2004

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EXAMINER

RAYMOND, RICHARD L

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,190

Applicant(s)

SHIOKAWA ET AL.

Examiner

Richard L. Raymond

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/017,641.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Change of Examiner

1. Note the change of Examiner in the present application. The Art Unit number (1624) remains the same.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 07/017,641, filed on February 24, 1987.

Reissue Applications

3. The original reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) as it does not set forth a specific error being corrected in this reissue application. The subject matter of the originally filed claims of related reissue SN 08/254,202 is now divided among that application and four divisional reissue applications, the present application being one of them. The same original declaration is not seen sufficient for each of these five applications. Each declaration must point out an (the) error being corrected in the reissue application in which it is filed. Submission of new declarations appropriate for each of the now pending applications is required.

4. Claims 1-5 and 7-9 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.
5. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Surrender of Original Patent

6. The original patent has been surrendered in the response of October 12, 2002 in related reissue SN 08/254,202.

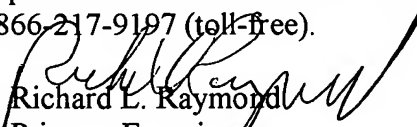
Allowable Subject Matter / Conclusion

7. Upon correction of the defective declaration above, the claims of the present application will be allowable. Interference proceeding will then be considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (571) 272-0673. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Richard L. Raymond
Primary Examiner
Art Unit 1624

rr
May 3, 2004

DO NOT SCAN THIS DOCUMENT INTO IFW.

Revised – 3/18/04

**PATENT EXAMINER
REISSUE APPLICATION CHECKLIST FOR PAPER REISSUES**

Examiner: Richard Raymond

Art Unit : 162-1

Reissue Appl. No.: 101,067,190

THIS CHECKLIST IS PROVIDED AS AN AID TO THE REISSUE EXAMINATION PROCESS. IT SHOULD BE USED THROUGHOUT PROSECUTION AND MUST BE REMOVED FROM THE FILE AT THE TIME OF ALLOWANCE AFTER APPROVAL BY THE SPRE.

Reissue applications are considered “SPECIAL” (MPEP § 1442). Any reissue application appearing on an examiner’s docket report should be taken up for action as the next new or amended case, even before other special applications.

Prior to examining a reissue application, the examiner should obtain and review the original patent file (MPEP § 1440). Examination of the reissue application is frequently directly linked to the prosecution history of the original application for the patent to be reissued.

ALL CLAIMS IN THE REISSUE APPLICATION ARE SUBJECT TO A FULL EXAMINATION ON THE MERITS, INCLUDING THE RE-PRESENTED ORIGINAL CLAIMS OF THE PATENT.

Examiner: Complete items 1-20 prior to completing a first action. Then, take the reissue application (and patented file, if available) to the SPRE for review, before mailing the action.

____ (SPRE initials) SPRE has reviewed before first action.

Complete items 21-22 when preparing the reissue application for allowance. SPRE must initial the file wrapper at the time of review for allowance.

A “Reissue Guide” containing a further explanation of each of the items on the checklist is available in paper form or electronically (by e-mail) from the Technology Center SPRE or Paralegal.

Reissue Application Checklist for Paper Reissues

Indicate that each of the applicable items set forth below has been thoroughly reviewed with respect to the above-identified reissue application by answering YES, NO, or N/A to the following questions. See TC SPRE for further assistance, if needed.

- YES 1. **Has the original patent file wrapper been obtained and reviewed?** *If NO, see "Reissue Guide" for further assistance.*
- YES 2. **Is the (original) patent still in force, i.e., has not expired due to the conclusion of its term or due to the non-payment of the scheduled maintenance fees?** *A reissue application must actually issue as a reissue patent before expiration of the original patent. Accordingly, always make sure the patent will not expire during prosecution of the reissue application. See "Reissue Guide" for methods of checking patent term.*
- YES 3. **Has notice of the filing of the reissue application been published in the Official Gazette (O.G.)?** *If NO, STOP action and have your TC Paralegal forward the application to OIPE to effect publication. Reissue RCEs are not announced in the O.G.*
- YES 4. **Is the current date more than two months after the O.G. publication date?** *If NO, wait until the two-month period has expired before preparing and issuing an Office action, unless directed otherwise by a decision of the Office of Patent Legal Administration or Office of Petitions in the file. Continuation/divisional reissues may be acted upon before the expiration of the two-month period.*
- YES 5. **Has the file been reviewed for the presence of any protests under 37 CFR 1.291(a)?** *Protests may be filed during the two-month period following the O.G. notice, or anytime up until the Notice of Allowance, and should be considered in the next Office action, if in the file. See "Reissue Guide" for instructions on handling protests.*
- related 6. **Is the reissue application a division or a continuation of another pending reissue application, or is there a child reissue application that is a division or continuation of this application?** *See In re Graff, 42 USPQ2d 1471. If YES, special handling as per "Reissue Guide" is required. See Item 19 below for restriction practice.*
- NO 7. **Is the patent or the reissue application involved in litigation?** *Information may be found in file or requested from STIC. If YES, shortened reply periods may have to be set by the Examiner, or prosecution may have to be suspended. See "Reissue Guide." If NO, proceed with examination.*

Reissue Application Checklist for Paper Reissues

- YES 8. If the reissue application has been assigned, does it include the written consent to the filing by all of the assignees (37 CFR 1.172(a))? See MPEP § 1410.01. *If NO, and a petition for a waiver of this requirement has been granted, the assent may be deferred until the case is otherwise allowable.*
- YES 9. Have all documents (in applications filed on or after September 24, 1992) which are signed by, or on behalf of, the assignee(s) been checked and found to comply with the provisions of 37 CFR § 3.73(b)? *This includes "consent" in No. 8, above. If NO, the statement under § 3.73(b) must be required before allowance.*
- NO 10. Were any changes made to the patent by a Certificate of Correction dated prior to the filing of the reissue? *If YES, check to see if the changes were properly entered as though part of the original patent, i.e., no brackets or underlining.*
- YES 11. Has the application been reviewed for the presence of any errors, including any not specifically identified, which are not correctable by reissue? *Reissue doesn't cure all patent ills. See "Reissue Guide" for listing of some errors which cannot be corrected by reissue.*
- NO 12. Are any claims broader in scope (in ANY respect) than the original patent claims? *If YES, note 35 USC 251, 3rd and 4th paragraphs. If NO, proceed to item 14.*
- 13. Does the broadening (from Item 12) attempt to "recapture" any claimed subject matter which was deliberately added, or argued, to overcome a rejection in the original application? *See "Reissue Guide" for explanation of "recapture doctrine." Subject matter deliberately surrendered may not be recaptured (reclaimed) in a reissue application.*
- YES 14. Has: (1) the original patent been surrendered OR (2) does the application contain a statement that the original patent is lost or misplaced? *If NO, the application cannot be allowed until either (1) or (2) is obtained.*
- YES 15. Does the reissue application seek to provoke an interference with another patent? *If NO, proceed to Item 17. If YES, see "Reissue Guide."*
- NO 16. Do the issues of interference estoppel and the "lost count" doctrine apply? *Applies to losing party of an interference. See "Reissue Guide."*

Reissue Application Checklist

NO 17. Does the application include drawings (copies or originals) which meet the requirements of 37 CFR 1.84? If YES, be sure there are no amendments or additions to the original figures. Transfer of the drawings from the patent file is not done by the Office.

YES 18. Does the reissue oath or declaration comply with all of the requirements of 37 CFR § 1.63 and 37 CFR § 1.175? See list of requirements in "Reissue Guide." If NOT, reject under 35 U.S.C. 251 (citing relevant portion of 37 CFR 1.63 or 1.175).

NO 19. Does the reissue application contain claims to more than one invention? 37 CFR 1.176. If yes, and the several inventions were claimed in the patent, a restriction requirement dividing the several inventions cannot be made in the reissue. If added claims in the reissue are drawn to an invention not previously claimed, a restriction is possible. See Reissue Guide.

NO 20. Is the original patent currently involved in a reexamination proceeding? To determine this, check "Continuity" in PALM for the original patent number. If YES, forward all related files (including any reexam or reissue directed to the original patent) to the Office of Patent Legal Administration (OPLA) for consideration of a merger of the proceedings.

THE FOLLOWING QUESTIONS SHOULD BE COMPLETED WHEN PREPARING THE APPLICATION FOR ALLOWANCE:

___ 21.. Have all amendments to the specification, drawings and claims been reviewed and found to comply with 37 CFR § 1.173(b)? See amendment practice described in "Reissue Guide." If NO, amendment in accordance with § 1.173(b) will be required.

___ 22. The following items should be verified at the time of Allowance:

___ a. None of the original patent claims have been renumbered.

___ b. Final numbering of claims added by reissue must follow the number of the highest numbered patent claim.

___ c. The claim selected for printing is one which was added or amended during reissue - never a canceled claim. (Where no claim is amended/added, print the same claim printed in the original patent).

___ d. On the inside left flap of the file-wrapper, the final claim numbering must be filled in properly. A canceled patented claim retains its original number although not considered in the total number of claims allowed. Therefore, on the face of the file-wrapper, the number in the box designated "Total Claims" under "CLAIMS ALLOWED" may be less than the highest number of the last allowed claim.

Reissue Application Checklist

- ____ e. The original patent number **must** be placed on the file wrapper face after the examiner's initials following "Surrender of Original Patent" for 09/ series applications, on the left inside flap for 10/ series applications, or on the Issue Classification (Blue) Slip in the block below the applicant's name for 08/ or earlier series applications).
- ____ f. Any Examiner's Amendment which makes changes to the patent which are substantive in nature may necessitate a supplemental reissue oath/declaration from applicant.
- ____ g. Classification and cross referencing on the file wrapper face for 09/ series applications , on the left inside flap for 10/ series applications, or on the Issue Classification (Blue) Slip for 08/ or earlier series applications should include at least those classes and subclasses designated on the original patent. If a reclassification prevents use of the same class/subclasses, the new class/subclasses should be used.
- ____ h. Terminal Disclaimer (TD) information has been placed on the file wrapper face for TDs filed either in the original patent or in the reissue application.
- ____ i. The references cited in the original patent have been cited in the reissue application on a Form PTO-892 or PTO-1449.
- ____ j. For any error corrected, which is not covered by an oath or declaration, i.e., any error corrected after the filing of all declarations currently in the reissue application, applicant **MUST** submit a supplemental oath or declaration prior to allowance stating "[T]hat every such error arose without any deceptive intention on the part of the applicant" (37 CFR 1.175(b)(1)), or language equivalent thereto. See MPEP 1444 for handling supplemental oaths/declarations.

Each allowed reissue application, together with the original patented file, is submitted to the TC SPRE for review prior to being released from the Technology Center. The box provided for "FINAL SPRE REVIEW" on the face of the reissue file wrappers is to be initialed by the TC SPRE. Once the reissue has been approved and revised for issue, the files should be sent to the Office of Patent Legal Administration.

This checklist is to be removed from the file by the SPRE at the time of final review

All reissue applications are screened by the Office of Patent Legal Administration (OPLA).

Examiner: _____

Date: _____